SUPREME COURT, U. S.

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IN THE

Supreme Court of the United States

October Term, 1968

No. 948

KAISER INDUSTRIES CORPORATION,
VEREINIGTE OESTERREICHISCHE EISEN-UND
STAHLWERKE AKTIENGESELLSCHAFT, and
BRASSERT OXYGEN TECHNIK AG.,
Petitioners,

v.

McLOUTH STEEL CORPORATION,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI

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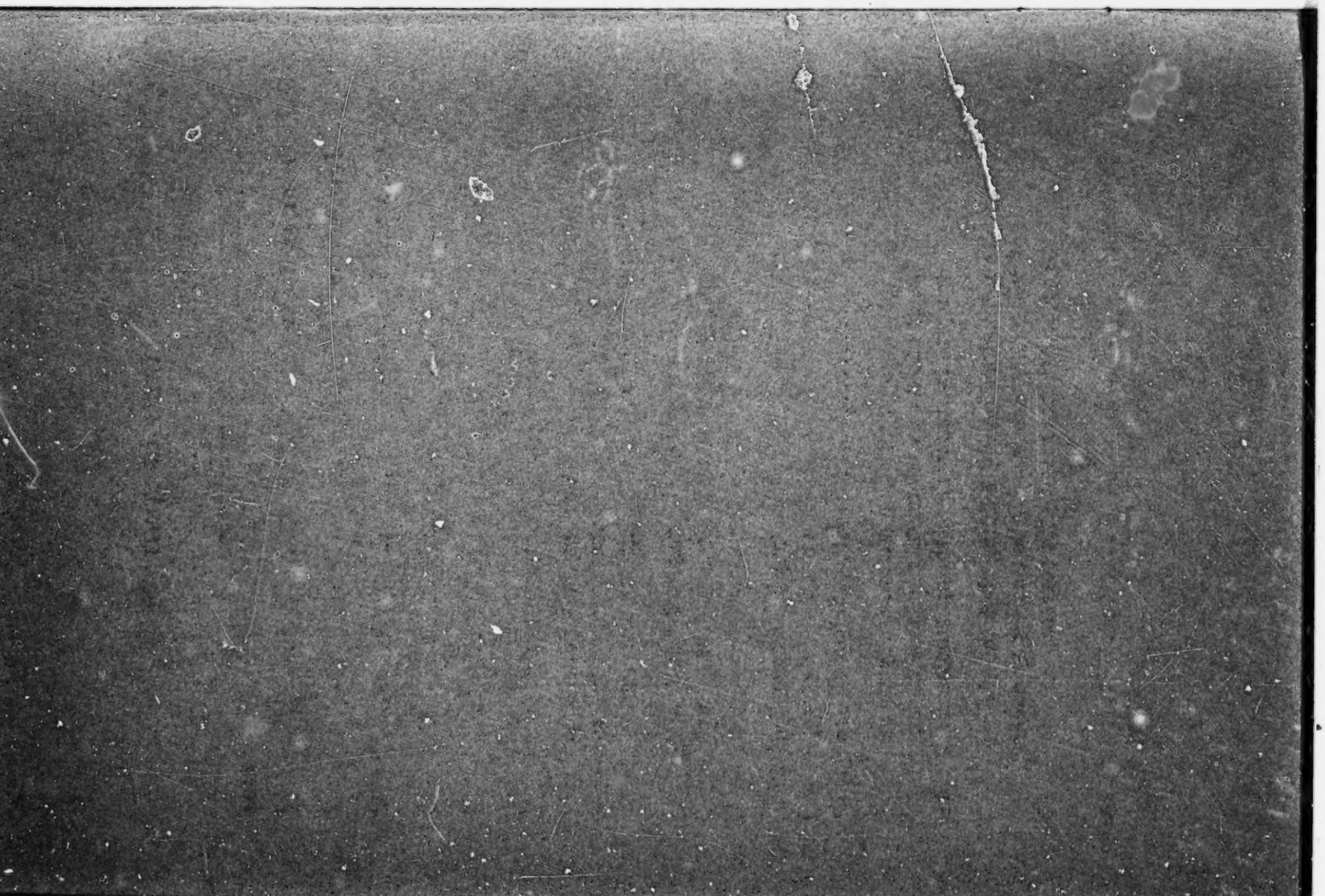

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There is nothing about this ordinary patent case which warrants review by this Court.

The decisions of the District Court and of the Court of Appeals concurred in holding that the patent in suit, Suess No. 2,800,631, was invalid for two reasons: (a) because the claims did not comply with Section 112 of the Patent Act of 1952, and (b) because the claims attempted to extend their monopoly to something already patented. On both grounds, the evidence overwhelmingly supports these decisions.

The Petition does not and cannot rely on any of the reasons set forth in this Court's Rule 19: there is no conflict between decisions of Courts of Appeals; there is no question of public importance; there has been no departure from the accepted and usual course of judicial proceedings;

and there is no special or important reason why the Writ prayed for should be granted (*General Pictures Co.* v *Electric Co.*, 304 U. S. 175, 178-179 (1938)).

Opinions Below

The Opinion of the United States District Court for the Eastern District of Michigan is reported at 257 F. Supp. 372, and that of the Court of Appeals for the Sixth Circuit at 400 F. 2d 36. These opinions are printed in Petitioners' Appendix, respectively, at pages 45a through 204a, and 1a through 43a.*

Jurisdiction

The jurisdictional requisites are set forth in the Petition.

Questions Presented

Petitioners' statement of the questions presented—which is highly argumentative—might be more accurately and simply stated

> Where both lower courts concurred on the facts in holding that the claims of the patent in suit were invalid because they overclaimed the invention and because they covered the prior art, is there any reason which would justify the intervention of this Court?

Statute Involved

Section 112 of the Patent Act of 1952 (35 U. S. C. § 112) so far as pertinent, provides

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* For convenience, reference to either opinion will be to Petitioners' Appendix, cited "App. p. "; the transcript of the trial record will be referred to as "R. p. " and trial exhibits as "Px ", or "Dx "; italics and brackets within quotes are ours unless the contrary is noted.

"The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same . . .

"The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention".

Statement of the Case

It is necessary, at the threshold, to correct a misstatement made and repeated in the Petition, which, unless corrected, misleads.

The Petitioners, again and again, attempt to identify the process of the Suess patent in suit with the process of basic oxygen steelmaking and to represent the patent as covering that process. Thus, the Petition speaks of "a patent on what is concededly a revolutionary steelmaking process" (Pet. p. 7), or, ambiguously, of the patent, which "is addressed to the famous L-D or basic oxygen steelmaking process invented in Austria" (Pet. p. 3), or to the basic oxygen process "disclosed in the patent" (Pet. p. 9; see also pp. 15, 21, 22, 26).

The basic oxygen steelmaking process admittedly may be called "revolutionary", but the patent in suit does not cover that process. It came late upon the scene and was preceded by a host of patents, as is made entirely clear by the file histories of the two Suess applications, upon which the patent in suit issued (Px 2B and 2A).

The non-revolutionary character of the original Suess application is highlighted by the trifling nature of the advance claimed—a so-called ratio of bath depth to bath area (Px 2B, pp. 10-12). These claims "were four times

rejected by the Patent Office" (App. p. 54a), and, as noted by both Courts below, bore no relationship to the subject matter claimed in the patent in suit (App. pp. 26a, 54a).

The claims of the 1955 continuation-in-part application, like those of its predecessor, were again rejected (Px 2A, pp. 58-60). However, on June 11, 1957, an amendment was filed (Px 2A, pp. 72-95), cancelling all claims and bringing in two new claims, which with a single amendment, became the claims of the patent in suit. This June 11th amendment, completely changing the nature of the claimed invention, was heralded by the significant statement that "information recently made available", but coming six and a half years after the original application, indicated that the pending application disclosed "a fundamentally different approach . . . than was suggested heretofore" (Px 2A, p. 74; App. p. 215a). Six days later, a further amendment was made (Px 2A, pp. 96-97), and on June 27, 1957—sixteen days after the "different approach" amendment—the patent was allowed (Px 2A, p. 100).

The "different approach" claims, as allowed, were couched in language which conflicted with, or had no antecedent or support in the specification.

The holding of invalidity, in large part, is based on the unusual character of these claims. After the most painstaking analysis, the District Court concluded that

> "The claims of the patent in suit do not measure the invention of the applicants; they do not accurately define or correctly describe just what the applicants invented; they do not find adequate support in the specification; and they do not clearly distinguish what is claimed from what went before in the art. Therefore, the claims do not meet the requirements of 35 U. S. C. § 112, and the patent in suit must be held invalid. 35 U. S. C. § 282(3)" (App. p. 201a).

The Court of Appeals affirmed on these grounds (App. pp. 2a, 33a).

Reasons for Denying the Writ

1. The decisions below, holding that the claims of the patent are invalid because they fail to comply with § 112, are manifestly correct.

Section 112 requires that the claims of a patent shall "particularly [point] out and distinctly [claim] the subject matter" of the invention.

Two rules governing the application of this section are apposite. These are stated by this Court as follows:

First, in *United Carbon Co.* v. *Binney Co.*, 317 U. S. 228, 236-237 (1942), it was said

> "The statutory requirement of particularity and distinctness in claims is met only when they clearly distinguish what is claimed from what went before in the art and clearly circumscribe what is foreclosed from future enterprise . . . the claims must be reasonably clear-cut to enable courts to determine whether novelty and invention are genuine . . . Whether the vagueness of the claim has its source in the language employed or in the somewhat indeterminate character of the advance claimed to have been made in the art is not material. An invention must be capable of accurate definition, and it must be accurately defined, to be patentable".

So also *Gen. Electric Co.* v. *Wabash Co.*, 304 U. S. 364, 369 (1938); *Standard Brands* v. *Yeast Corp.*, 308 U. S. 34, 38, (1939).

And second, in *Schriber Co.* v. *Cleveland Trust Co.*, 305 U. S. 47, 57 (1938), it was held that the patent monopoly "cannot be enlarged by claims in the patent not supported by the description". So also *Permutit Co.* v. *Graver Corp.*, 284 U. S. 52, 57-60 (1931); *Stelos Co.* v. *Hosiery Corp.*, 295 U. S. 237, 241-242 (1935).

Three of the five steps of the claims* of the patent in suit directly violate Section 112.

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* Claim 1 of the patent is quoted verbatim on page 213a of Petitioners' Appendix. Claim 2 is dependent on Claim 1.

a. The step of avoiding "material agitation" has no antecedent in the specification and is meaningless.

The second step of the claims calls for jetting the oxygen "to an extent to avoid material agitation of the bath by the oxygen stream" (App. p. 213a).

The specification neither refers to "material agitation" nor to its avoidance.

Dr. Hauttmann, one of the patentees, admitted that

> "It doesn't state anywhere in the patent that [material agitation] should be avoided" (R. p. 2412).

And Petitioners' experts, Drs. Chipman and Elliott, admitted that they could find no teaching of it in the patent (R. pp. 880, 886-887, 6626, 6627).

In the light of these admissions, the District Court had no alternative than to find

> "The term 'material agitation' or 'avoidance of material agitation' is admittedly not used or defined in the specification of the patent in suit. (R. 13,326, 13,327, 13,328; also plaintiffs' main brief, p. 190; Dr. Chipman, R. 879; Dr. Elliott, R. 6627; Dr. Hauttmann, R. 2412.)" (App. p. 169a; see also p. 30a).

The District Court highlighted the basic lack of meaning of the term by quoting from the testimony of three of Petitioners' principal witnesses:

> "In addition, persons skilled in the art who testified for plaintiffs did not seem to know what the language of the claims referring to material agitation meant or to be able to tell when the conditions of such agitation or its avoidance would exist. For example, when Dr. Hauttmann, one of the patentees, was asked: 'How would an operator practicing oxygen blowing tell when the agitation produced by the jet became material?', he answered: 'I do not know that.' (R. 2414.) When Mr. Prince, a metallurgical engineer employed by plaintiff Kaiser, was asked: 'When does agitation become material?', he finally

> replied: 'I don't know, Mr. Groner. It is just when agitation becomes material.' (R. 5784.) Also, when Dr. Chipman was asked: 'You don't know from anything in the patent when a harmless agitation becomes a material agitation, do you, Doctor?', he replied: 'I don't think so.' (R. 880.)" (App. pp. 177a-178a).

The Court could not avoid its conclusion that this step

> "could not have been a meaningful concept to persons skilled in the art at the time the invention was made, especially since the concept did not appear very meaningful to some of plaintiffs' expert witnesses even at the trial roughly fourteen years later" (App. p. 178a; see also pp. 176a-179a).

The Court of Appeals found this ruling "amply supported by the evidence" (App. p. 30a).

Notwithstanding this, Petitioners now argue that the avoidance of "material agitation" "*must* mean avoidance of the 'agitation produced by deep penetration'" (Pet. p. 25, italics in original).

This is unsound because the patent in suit neither teaches nor suggests any identity or relationship between the terms "deep penetration" and "material agitation", and those skilled in the art had no knowledge of such a relationship.

The District Court, having analyzed in minute detail the evidence adduced by Petitioners in an attempt to show such a teaching by the patent (App. pp. 172a-174a), concluded:

> "Thus on close examination, none of the references [in the specification] relied on by plaintiffs teach any causal relation between deep penetration and material agitation by the oxygen stream" (App. p. 174a).

Not only does the patent fail to teach such a relationship, but the evidence in this case shows that there is no inherent relationship between "deep penetration" and "ma-

terial agitation", or the avoidance of either. Thus, Dr. Hauttmann admitted that he could not say whether the agitation of the melt increased and decreased as the penetration increased and decreased (R. p. 2418; see also p. 2414). And Petitioners' expert, Dr. Chipman, did not know whether deep penetration would cause agitation of the bath (R. pp. 949-951; see also App. p. 180a-181a).

Seemingly, Petitioners no longer rely on a direct teaching by the patent or on general knowledge in the art. Instead, they attempt to sustain an identity between the terms by reference to affidavits filed in the continuation application in June 1957—six and a half years after the original application was filed—by Drs. Rinesch (Px 2A, pp. 78-87) and Hauttmann (Px 2A, pp. 88-95). Petitioners' position is baldly stated:

> "The fact that the definition of the terms in the claims was contained in affidavits filed with the Patent Office rather than in the patent itself is of no significance" (Pet. p. 28, n.; see also pp. 24-28).

But the law is to the contrary, and Petitioners' only support for their argument is based on distorting (Pet. pp. 22-23; see also pp. 4, 7, 16-17, 19-28) the thoroughly established rule, most recently stated in *Graham* v. *John Deere Co.*, 383 U. S. 1, 33 (1966), that

> "an invention is construed not only in the light of the claims, but also with reference to the file wrapper or prosecution history in the Patent Office".

However, as the *Graham* case makes plain, the rule is applied to limit words to the meaning given them by the patentee in order to secure the allowance of the patent, and has never sanctioned grafting on to the patent something not included in its express terms.

Thus, Petitioners' argument finds no support in the *Graham* case, and it runs directly counter to the requirements of the pertinent statute and of the case law.

Section 112 requires, in the specification, a "written description of the invention," which is "full, clear, concise, and exact" enough "to enable any person skilled in the art . . . to make and use the same."

Giving effect to the statute (specifically to RS § 4888, the predecessor of Section 112), this Court in the *Schriber* case, *ante* p. 5, held

> "the patent monopoly does not extend beyond the invention described and explained as the statute requires, *Permutit Co.* v. *Graver Corporation, supra,* at 57; [and] . . . it cannot be enlarged by claims in the patent not supported by the description . . . " (305 U. S. 57).

To the same effect, the Court of Appeals for the Seventh Circuit, in *Universal Oil Products Co.* v. *Globe Oil & Refining Co.*, 137 F. 2d 3, 6 (1943), aff'd 322 U. S. 471 (1944), said

> "the meaning which the inventor gives to his words can not be made to depend upon subsequent events, but should appear when the application is filed".

See also the *Permutit* case (*ante* p. 5), 284 U. S. 56-60.

The decisions below were in full accord with the requirements of the statute and with the rule set forth in the *Schriber* case. The District Court held that persons skilled in the art of steelmaking

> "would, of course, not be responsible for knowing the contents of affidavits filed more than seven years later" (App. p. 177a).

The Court of Appeals, to the same effect, stated

> "The patent law does not require a prospective inventor to search so far in attempting to determine the scope of a patent and the areas left open for inventive inquiry . . . a prospective inventor is required to go no further [than the specification or knowledge

> attributable to one skilled in the art] in attempting to determine the invention claimed and the areas foreclosed to future enterprise" (App. p. 30a).

There is nothing to support the argument of Petitioners, which is based on a perversion of the rule of the *Graham* case.*

b. The step of jetting the oxygen "onto and below the surface of the bath" is contrary to the teaching of the specification.

Up to ten days before the allowance of the patent in suit the claims had called for jetting the oxygen "against the surface of a bath" (Px 2A, p. 72). On June 17, 1957, however, this was changed so that the step required jetting "onto *and below* the surface" (Px 2A, p. 96).

The earlier provision was in accord with the teaching of the patent. The later and final form is in direct conflict with the specification. Illustratively, the specification taught jetting vertically "upon the central portion of the surface of a bath" (App. p. 208a, col. 3, ll. 36-39), or "onto the surface" (*id.*, col. 3, ll. 52-53), or to "the central portion of the bath surface" (*id.*, col. 4, ll. 29-30, 71-72; see also p. 207a, col. 1, l. 23; col. 2, ll. 38, 46, 59, 63; p. 208a, col. 3, ll. 19-20, 49; col. 5, ll. 32-33, 61-62; p. 212a, col. 11, l. 41).

On the strength of these teachings the District Court held

> "At least thirteen separate references in the specification of the patent in suit speak of 'surface

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* Going one step further, both the District Court and the Court of Appeals invoked a so-called file wrapper estoppel to give an *additional* reason for their conclusion that the avoidance of "material agitation" bore no relationship to the avoidance of "deep penetration" (App. pp. 164a-166a; 33a-43a). Since the conclusion that there is no relationship is overwhelmingly supported by the facts and the law, and is in no degree weakened or affected by disregarding the estoppel, it is not necessary to burden this Court with its consideration.

> blowing' or 'blowing onto the surface,' etc. But there is no reference anywhere in the specification to blowing 'below the surface,' as claimed. Col. 5, lines 61 and 62, speak of 'the confined zone of direct oxygen *reaction at the surface* of the molten metal bath,' (emphasis is added) which would seem to preclude a claim of blowing below the surface" (App. p. 193a, italics and parenthesis in original; see also pp. 193a-194a).

The Court of Appeals opinion does not discuss this failure of the patent to comply with the requirements of Section 112. However, its affirmance of the District Court apparently was intended to cover this (see App. pp. 2a-3a, 7a).

The teaching of the patent is perfectly understandable: that teaching is opposed to the first step of the claims. The District Court, under the circumstances, made the only possible holding, and that holding perfectly accords with the rule of the *Schriber* and *Permutit* cases (*ante* p. 5).

c. The step of producing a circulatory movement caused by chemical reactions is contrary to the teaching of the specification.

The fifth step of the claims, calling for the production of a circulatory movement in the bath caused by "said reaction", that is, the chemical reaction between the oxygen and the iron and the iron impurities, also made its initial appearance in the amendment of June 11, 1957. But, in opposition to this, the specification teaches that circulation is the result of the physical force of the jet (App. p. 208a, col. 4, ll. 28-34), and it teaches a different function for the chemical reaction to which the claims refer. Specifically, the specification teaches that the reaction between carbon (one of the iron impurities) and FeO and oxygen, with the formation of CO "causes a strong boil or agitation of the bath" (App. p. 208a, col. 4, ll. 60-67).

The District Court analyzed the pertinent parts of the patent on a line by line basis (App. pp. 187a-189a; see also pp. 190a-193a) and held

> "The claim of a circulatory movement in the molten metal produced by chemical reactions in a localized reaction zone is simply not supported by the teachings of the specification of the patent in suit. References relied on by plaintiffs in this connection do not teach a circulation induced by chemical reactions" (App. p. 187a).

Again, the holding is that impelled by the *Schriber* and *Permutit* cases.

2. The decisions below, holding that the claims of the patent are invalid because they cover the prior art, are manifestly correct.

The District Court considered in detail each step of the claims in the light of what the prior art taught, relying, in large measure, on the testimony of Petitioners' witnesses, and, particularly, on that of Petitioners' chief expert, Dr. Chipman (App. pp. 194a-198a). In the light of that analysis, the Court noted that "the distinction" between the claims and the art "may well be a purely verbal one". The Court further noted that Petitioners had had "considerable opportunity", both before and during trial, to demonstrate, by experiments, that distinctions existed, but that Petitioners "admittedly failed" to produce any such evidence (App. p. 198a).

The Court concluded

> "At trial, certain of plaintiffs' witnesses candidly interpreted the claims of the patent in suit as being so broad that any commercial steelmaking operation involving vertical blowing would necessarily infringe even if the operation were following prior art teachings, although the language of the new claims was clearly intended to distinguish the prior art patents. Such claims, if allowed, would flout the patent law of the United States" (App. p. 199a).

The Court of Appeals, in affirming, made a generally corresponding comparison (App. pp. 21a-31a).

The soundness of these holdings is demonstrated briefly by uncontested fact.

Dr. Trenkler, one of the patentees, admitted, in the words of the District Court,

> "that the only significant difference in practice over prior teachings was a reduction of the impact pressure of the jet and, therefore, a lesser penetration into the bath by the jet than would have resulted from prior teachings (R. 11, 905.)" (App. p. 101a).

Indeed, as the District Court found, this is the position of Petitioners (App. pp. 160a-161a; see also p. 126a). The Court of Appeals epitomized the situation in these words

> "In sum, the only difference between the Suess disclosure and the prior art is the teaching of avoidance of deep penetration as opposed to deep penetration" (App. p. 21a).

Despite having narrowed the issue to the single question as to the type of penetration which had to be avoided, Petitioners, with utter inconsistency, attempted to stretch the patent to cover Respondent's operation.

The result, as the Court of Appeals found, is that

> "the patentees now seek a broader description of that term encompassing any penetration of one half the bath depth or less" (App. p. 27a).

The District Court's summarization of the testimony of Petitioners' witnesses abundantly supports this conclusion (App. pp. 106a-107a).

But, in stretching the patent, Petitioners simply went from Scylla to Charybdis, and wound up with the patent squarely within the teachings of the prior art Schwarz patent. Schwarz taught that the reactions took place "in the center of the steel bath" (App. p. 234a, ll. 23-24), or, as Dr. Hauttmann expressed it, at "the middle of the melt" (R. p. 2525; see also Dx 15, p. 30).

The patent, therefore, makes no advance over Schwarz, and is invalid. The Court of Appeals understated the situation when it said

> "when it is once admitted that the oxygen jet penetrates into the bath to any not insubstantial degree, it becomes almost impossible to distinguish 'deep penetration' as taught by Schwarz and Miles from 'avoidance of deep penetration' as taught by the patentees" (App. p. 25a).

Conclusion

The Petition should be denied

Respectfully submitted,

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